



Trademarks Protection in Nigeria:

Registration Procedure and Enforcement of Rights

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Introduction

Trademarks play a significant role in the industrial and economic development of a country. A trademark is a “badge of origin.”¹ As an aspect of Intellectual Property, trademarks are concerned with the protection of goodwill and reputation of products and businesses.² By section 67 of the Trademarks Act, Cap T13, Laws of the Federation of Nigeria (LFN) 2004 (as amended) (the “**Trademarks Act**”), a trademark refers to a mark used or proposed to be used in relation to goods, including the shape of the goods and their packaging, for the purpose of indicating a connection in the course of trade between the goods and some persons having the right to use the mark, either as a proprietor or a registered user, with or without an indication of that person's identity. In other words, a trademark is a device, brand, logo, label, name, signature, word, letter, numeral, or any combination thereof, capable of distinguishing goods and services of a particular owner from another.

For a trademark to be protected under the Trademarks Act, it must be duly registered.³ The essence of registering a trademark is to protect its proprietor in the exclusive use of the trademark in connection with its goods and services. Adequate protection of trademarks also protects consumers right to make informed choices as to the purchase of quality products. In any event, a trademark owner of an unregistered trademark may still explore the protection under common law by an action for passing off in ensuring due protection of its goodwill.⁴

In Nigeria, the Nice Classification, which is the international classification of goods and services, established in 1957, is adopted for the description of goods and services in the registration of trademarks. This article highlights the procedure for the registration of trademarks, and the core rights of trademarks proprietors in Nigeria.

Utilization of Trademarks

The hallmark of a trademark is in its distinctiveness or uniqueness in relation to the goods or services in question as well as its proprietor. Trademarks are used to identify and distinguish a product or service belonging to a proprietor from that of another, as registration vests the exclusive right of use on a trademark proprietor.⁵

They also serve as means of identification of goods and services and also help to prohibit goods and services that are likely to lead to deception or confusion.⁶ Also, a trademark when registered may be assigned or licensed for a specified period.⁷

Legal Framework for Trademark Registration in Nigeria

Some of the laws governing the protection of trademarks in Nigeria are the (a) Trademarks Act; (b) Trademark Regulations, 1990; (c) Merchandise Marks Act Cap M10 LFN 2004; (d) Trademark Malpractices (Miscellaneous Offences) Act Cap T12 LFN 2004; and (e) Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous Provisions) Act, Cap C34 LFN 2004.

¹ Scandecor Development AB v. Scandecor Marketing AV [2001] UKHL 21 per Lord Nicholls.

² Paul Marret, *Intellectual Property Law* (Sweet & Maxwell 1996) 1.

³ Section 3 of the Trademarks Act.

⁴ *Niger Chemists Limited v. Nigeria Chemists* [1961] ANLR 180.

⁵ Section 5 of the Trademarks Act.

⁶ Section 11 of the Trademarks Act.

⁷ Section 26(1) and (2) of the Trademarks Act.

Grounds for the Opposition of a Trademark Registration

There are various grounds upon which an application for the registration of a trademark registration may be rejected, and these include where: -

- the trademark is likely to deceive or cause confusion, or is made up of a scandalous design;⁸
- where the word is commonly used and accepted as the name of a chemical element or chemical compound as distinguished from a mixture;⁹
- the trademark is identical with a trademark belonging to a different proprietor and is already on the register relating to similar goods/services;¹⁰
- the trademark contains words such as 'patent', 'patented', 'registered', 'registered design', or 'copyright'; and
- the trademark consists of words such as "Red Cross" or "Geneva Cross" or the representation of the Geneva or other crosses in red or of the Swiss Federal Cross in white or on a red background or in a silver on a red background or any such similar representation.

Trademark Registration Procedure

Trademark registration and protection is territorial in nature and the rights to a trademark do not generally extend beyond the territory in which such rights are granted. Accordingly, a registered trademark under the Trademarks Act is limited to Nigeria and does not extend to other territories.

It takes between twelve (12) and eighteen months (18) months to register a trademark in Nigeria where there are no oppositions. An applicant is required to furnish certain vital information to aid the registration of trademark. These are:

- a. name, nationality, and address of the proprietor of the trademark;
- b. representation of the trademark (such as the device/logo);
- c. specification of goods/services for which the trademark is sought to be registered;
- d. the class of goods/services in accordance with the Nice Classification; and
- e. an executed power of attorney (Form 1) in favour of an agent or attorney.

The steps involved in registration of trademarks in Nigeria are enumerated below:

1. Availability Search

The first step required in the registration of a trademark is to conduct an availability search to identify if the proposed mark is registrable and to ensure that the proposed mark does not conflict with any existing trademark in the proposed class(es) in order to avoid any form of infringement.

2. Filing of the Proposed Trademark

Upon the completion of the search and confirmation that the proposed mark does not conflict with any existing trademark, the proposed trademark is then filed via the registration portal. An acknowledgement form is thereafter issued on the portal by the Trademarks Registry.

⁸ Section 11 of the Trademarks Act. A design is said to be scandalous when it causes public outrage as a result of its immorality.

⁹ Section 12 of the Trademarks Act.

¹⁰ Section 13 of the Trademarks Act.

3. Acceptance of the Trademark

After the mark is filed, it is then examined by the Registrar of Trademarks and if accepted, an acceptance letter is issued within 1-3 weeks. The acceptance letter is admissible as evidence against the filing of similar or identical marks by another proprietor in the future.

4. Publication in the Trademarks Register and Filing of Opposition

Upon the mark being accepted, it is then published in the Trademarks Journal. The trademark application is then opened for oppositions (if any) to be filed. The opposition period is within two months of the publication in the Trademarks Journal. In the event that a notice of opposition is filed against a trademark, the Registrar shall send the notice of opposition to the applicant, and it is expected that a counter statement be filed by the applicant stating the grounds relied upon.

Where a counterstatement is filed by the applicant, a copy of it is sent by the Registrar to the opposing party. The parties are then required to exchange evidence, after which a hearing date is fixed, and on the conclusion of such hearing, the Registrar then decides whether or not the trademark registration is to be permitted. The decision of the Registrar is subject to appeal at the Federal High Court.¹¹

5. Issuance of the Certificate of Registration

In the absence of any opposition to the trademark or where an application for opposition has been resolved in favour of an applicant, the Registrar shall proceed to register the trademark and issue to the applicant a certificate of registration in the prescribed form with the seal of the registrar.¹²

Upon registration of a trademark, the registered trademark is valid for an initial period of seven (7) years, after which it can be renewed for additional periods of 14 years.¹³

Rights of a Trademark Proprietor

By section 5 of the Trademarks Act, a proprietor whose trademark registration is valid and subsisting has the exclusive right to use the trademark in the marketing of his goods and services.

In *Dyktrade Limited v. Omnia Nigeria Limited*,¹⁴ the Supreme Court held, that a trademark when registered, will entitle the proprietor to sue or institute an action at the Federal High Court¹⁵ for any infringement of the trade mark. A trademark owner has the exclusive right to institute an action to seek redress for any infringement.

A registered trademark also confers the right of assignment or transmission on the trademark proprietor either in connection of the goodwill of the business or not.

A trademark proprietor has the right to prevent a third party from using an identical or similar trademark during business. In *Morison Industries Plc v. CPL Industries Limited*,¹⁶ the Court of Appeal stated that the

¹¹ Section 21 of the Trademarks Act.

¹² Section 22(3) of the Trademarks Act.

¹³ Section 23(1) of the Trademarks Act.

¹⁴ [2000] FWLR (Pt 10 - 13) 1785.

¹⁵ Section 251(1)(f) of the Constitution of the Federal Republic of Nigeria vests jurisdiction over trademark protection matters on the Federal High Court.

¹⁶ (2021) LPELR- 52981 (CA).

reason for the protection offered by the Trademarks Act is to ensure that that only the registered proprietor of a trademark is entitled to use the mark.

A registered trademark can be used as a subject of security interest. Section 65(2) of the Trademarks Act provides that equities in respect of a trademark can be enforced like a personal property.

Enforcement of Trademark Rights.

There are various modes for the enforcement of trademarks in Nigeria and these include:

a. Filing of Opposition

Upon the acceptance of the trademark by the Trademark registry, it is then published in the Trademark Journal and open for opposition (if any) to be filed within two (2) months. A notice is opposition is made known to the Applicant, who is expected to file a counter statement. The Trademarks Registry is entitled to preside over opposition proceedings and can take further administrative actions with respect to proposed registrations.

b. Cease and Desist Letters

This involves a trademark proprietor writing a letter to an infringing entity, informing the entity on the proprietor's exclusive right to use such mark, and warning such entity to deter from further acts of infringement.

c. Institution of an Infringement Action before the Federal High Court

The Federal High Court has the exclusive jurisdiction over trademark matters. By section 3 of the Trademarks Act, only a registered trademark can be enforced as no person shall be entitled to institute any proceeding to prevent, or to recover damages for the infringement of an unregistered trademark. The trademark proprietor of an unregistered trademark may however resort to the common law relief through an action for passing off to protect his goodwill

d. Enforcement by other Regulatory Agencies

There are also other agencies/regulatory authorities in Nigeria that assist in the enforcement of trademarks in Nigeria, and these include the – **(a)** Federal Competition and Consumer Protection Commission, **(b)** Economic and Financial Commission (the “**EFCC**”), **(c)** National Agency for Food and Drug Administration, **(d)** Standards Organization of Nigeria, and **(e)** Nigerian Internet Registration Association (“**NIRA**”) etc.

The Federal Competition and Consumer Protection Commission Act, 2018 (the “**FCCPA**”) prohibits any undertaking from knowingly applying for any goods, a trade description or trademark in a manner that is likely to deceive consumers.¹⁷ Also, the EFCC is empowered to investigate economic and financial crimes including the theft of Intellectual Property.¹⁸ NIRA specializes in helping trademark owners protect and enforce their rights against abusive and bad faith registration in relation to trademark and domain name matters.

¹⁷ Section 116 of the FCCPA.

¹⁸ Section 6 of the EFCC Act.

e. **Criminal Liability for Trademark Infringement**

The Merchandise Marks Act, Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous Provisions) Act and Cybercrimes (Prohibition and Prevention) Act, 2015 provide for criminal liabilities and consequences for trademark infringement in Nigeria.

The Merchandise Marks Act criminalizes trademark and trademark description-related offences, such as forgery of trademarks, false application to goods of any trademark or any marks so nearly resembling a trademark, as to cause deception. A person who is convicted of an offence provided for in the Merchandise Marks Act is liable to imprisonment for six months and a fine, however if a person is convicted by virtue of proceedings before the Federal High Court, the offender is liable to imprisonment for two years or a fine or both.¹⁹

The Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous Provisions) Act,²⁰ prohibits the sale, distribution, importation, and possession of counterfeit, adulterated, or fake drugs and unwholesome, processed food. Any person convicted is liable to a fine not exceeding ₦500,000 or a term of imprisonment of not less than five years or more than fifteen years, or both a fine and imprisonment.

A person is also prohibited from intentionally making use of a trademark on the internet or any other computer network without authority or right and for the purpose of interfering with the use by the owner. The person shall upon conviction be liable to imprisonment for a term of not more than two years or to a fine of ₦5,000,000 or both.²¹

Criminal prosecutions of trademark infringement can be done by the Police and Attorney General (of either the Federation or a state). A private individual can also pursue a criminal prosecution, where such person has been granted a fiat by the Attorney General to prosecute offenders on his behalf.²²

Conclusion

Trademarks serve the important function of origin, distinction, guarantee of quality and advertising for particular products. Accordingly, it is important for proprietors to actively take steps to protect their marks through prompt registration.

There should be a more concerted effort in the enforcement of trademark proprietors' rights and the fight against trademark infringement. All hands need to be on deck and innovative mechanisms should be implemented by the government, regulatory authorities, and stakeholders.

¹⁹ Section 3 of the Merchandise Marks Act 2004.

²⁰ Sections 1- 3 of the Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous Provisions) Act.

²¹ Sections 25 of the Cybercrimes (Prohibition and Prevention) Act, 2015.

²² Sections 150 and 195 of the Constitution of the Federal Republic of Nigeria, 1999 (as amended).

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